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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,500	09/22/2000	Hatim Amro	16356.550 (DC-02468)	1986
27683	7590	11/04/2003	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			NGUYEN, QUANG N	
			ART UNIT	PAPER NUMBER
			2141	6
DATE MAILED: 11/04/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/668,500

Applicant(s)

AMRO ET AL.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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***Detail Action***

1. This Office Action is in response to the Pre-Amendment A filed on 03/19/2002. Claims 1-22 are presented for examination. Claim 16 has been amended. Claims 21-22 have been added as new claims.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**3. Claims 1-4, 6-11, 13-19 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Jain (US 6,480,853).**

4. As to claim 1, Jain teaches a method comprising:  
receiving a search term and an identifier associated with a bookmark (block 200)  
(Jain, C7: L16-20);

searching a database using the search term (block 214) (Jain, C7: L30-32); and  
searching a website associated with the bookmark using the search term (block  
204) (Jain, Fig. 5 and corresponding text, C7: L23-26).

5. As to claim 2, Jain teaches the method of claim 1, further comprising:  
searching the website associated with the bookmark in response to an indicator  
being selected (Jain, Fig. 4 and corresponding text, C5: L48-55).

6. As to claim 3, Jain teaches the method of claim 1, further comprising:  
providing a result of searching the website associated with the bookmark to allow  
the result to be displayed (block 212 of Fig. 5) (Jain, C7: L27-30).

7. As to claim 4, Jain teaches the method of claim 3, further comprising:  
displaying the website in response to the result being selected (Jain, C2: L11-  
18).

8. As to claim 6, Jain teaches the method of claim 1, further comprising:  
providing the search term and the identifier associated with the bookmark to a search engine (web server/ search engine 26 of Fig. 2) (Jain, C7: L16-20);  
searching the database using the search term in response to the search engine receiving the search term (Jain, C7: L30-32); and  
searching the website associated with the bookmark using the search term in response to the search engine receiving the identifier (Jain, C7: L23-26).
9. As to claim 7, Jain teaches the method of claim 1, further comprising:  
accessing a file (i.e., a cookie) that includes the bookmark; and  
creating the identifier in response to accessing the file (i.e., the search engine receives and is configured to interpret the cookie and search the bookmarks contained there within) (Jain, C6: L38-49).
10. Claims 8-11 and 13-15 are corresponding system claims of method claims 1-4 and 6-7; therefore, they are rejected under the same rationale.
11. Claims 16-19 are corresponding computer program product claims of method claims 1-3; therefore, they are rejected under the same rationale.

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12. As to claim 21, Jain teaches a method for searching websites associated with bookmarks, comprising:

receiving a search term and an identifier associated with a bookmark (Jain, C7: L16-20);

accessing a file (i.e., a cookie) that includes the bookmark (Jain, C6: L38-49);

creating the identifier in response to accessing the file (i.e., the search engine receives and is configured to interpret the cookie and search the bookmarks contained there within) (Jain, C6: L38-49).

searching a database using the search term (Jain, C7: L30-32); and

searching a website associated with the bookmark using the search term (Jain, Fig. 5 and corresponding text, C7: L23-26).

13. Claim 22 is a corresponding system claim of method claim 21; therefore, it is rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**15. Claims 5, 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain, in view of Himmel et al. (US 6,324,566), herein after referred as Himmel.**

16. As to claim 5, Jain teaches the method of claim 3, but does not explicitly teach displaying an advertisement associated with the bookmark in response to displaying the result.

In the related art, Himmel teaches a method for Internet advertising via bookmark set based on client specific information (i.e., client search term/request), wherein an advertisement (e.g., banners/bookmarks to web pages containing articles on such client search term/request/topic) associated with the bookmark (result) set would be included, downloaded and displayed with the result set to the user (Himmel, C10: L43-61).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Jain and Himmel for displaying an advertisement associated with the bookmark in response to displaying the result because it would allow provide a new electronic advertising medium through a search engine site and provide users with additional valuable information and services related to the user requested information/topic.

17. Claims 12 and 20 are corresponding system and computer program product claims of method claim 5; therefore, they are rejected under the same rationale.

18. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

19. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

A handwritten signature in black ink, appearing to read 'Le Hien Luu', with a long horizontal flourish extending to the right.

LE HIEN LUU  
PRIMARY EXAMINER